

Remarks

Claims 1, 2, and 4-6 were pending in the subject application. By this Amendment, new claim 7 has been added. Support for the new claim can be found throughout the subject specification and in the claims as originally filed (for example, page 5, line 32 through page 6, line 2, and original claim 1). Entry and consideration of the new claim presented herein is respectfully requested. Accordingly, claims 1, 2, and 4-7 are currently before the Examiner.

Claims 1, 2, and 4-6 have been rejected under 35 U.S.C. §103(a) as obvious over Xu *et al.* (U.S. Patent Application No. 2003/0154659) in view of Li (U.S. Patent Application No. 2002/0173252) and/or Akahori *et al.* (U.S. Patent Application No. 2004/0147206) and further in view of Maeno *et al.* (U.S. Published Patent Application No. 2003/0181349). The applicants respectfully traverse this ground for rejection because the cited references, either taken alone or in combination, do not teach or suggest the subject invention.

The Office Action asserts that it would have been obvious to include the polyoxyethylenealkylamine nonionic surfactant of the present invention with the polishing composition of Xu *et al.*, based on the disclosures of Li, Akahori *et al.*, and Maeno *et al.* The applicants respectfully disagree. As discussed in the Amendment of June 18, 2008, Xu *et al.* teach that “dispersing... is optional” and is accomplished “by stirring by a vane-type stirring machine or by ultrasonic dispersion” (see paragraph [0018]). The Office Action indicates at page 5 that this is not relevant because “an optional limitation does not exclude the presence thereof” and “a reference is not only limited (by) the examples defined therein.” However, the applicants respectfully point out that, to establish a *prima facie* case of obviousness, the Examiner must show that “there was an apparent reason to combine the known elements in the fashion claimed” by the applicant. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); MPEP §2142. Additionally, “there must be some reason for the combination other than the hindsight gleaned from the invention itself.” *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed.Cir.1985).

Thus, the applicants submit that the statements in paragraph [0018] of Xu *et al.* are relevant to whether a skilled artisan would have had a reason to include the dispersant of the present invention in the Xu *et al.* composition. In this case, the Xu *et al.* reference teaches that dispersion is

not required in its composition. Also, even if one of skill in the art were to create the Xu *et al.* composition and desired dispersion, Xu *et al.* teach that such dispersion is achieved by stirring or ultrasonic dispersion. There is no suggestion in Xu *et al.* of the use of a surfactant such as the one used in the present invention. That is, even though Xu *et al.* do not exclude the presence of a surfactant, a skilled artisan would not have had a reason to include one.

Additionally, the Office Action cites paragraph [0019] of Xu *et al.* for disclosure of a dispersant and then declares at the bottom page 4 that the claimed ranges are taught by Xu *et al.* if the composition is taken prior to dilution. First of all, Xu *et al.* only mention the use of a dispersant in this one paragraph and only in the context of dilution; there is no disclosure of a surfactant, such as the one required by the claimed invention. Also, Xu *et al.* only disclose the use of this dispersant as the composition is being diluted. Thus, even if it is assumed, for the sake of argument, that a skilled artisan could interpret this mention of a dispersant as a teaching to use a surfactant, it would only be included with the diluted composition, which the Office Action admits does not satisfy the elements of the claimed invention.

The Action cites Li and Akahori *et al.* for the proposition that a surfactant should be used in the Xu *et al.* composition. The applicants respectfully reiterate that Li clearly states that ionic surfactants are more effective in paragraph [0057]. The Office Action dismisses this fact at page 6 by stating that nonionic surfactants are also taught and “a reference can be used for all it realistically teaches.” However, it has been well established in the patent law that the mere fact that the purported prior art could have been modified or applied in some manner to yield an applicant’s invention does not make the modification or application obvious unless “there was an apparent reason to combine the known elements in the fashion claimed” by the applicant. *KSR, supra*. Furthermore, an applicant’s invention is not “proved obvious merely by demonstrating that each of its elements was, independently, known in the (purported) prior art.” *Id.*

In this case, if a skilled artisan had combined the teachings of Li and Xu *et al.*, there would have been no reason to use a nonionic surfactant. The only disclosure in either reference that a surfactant can be used is in Li, which unequivocally declares that ionic surfactants are more effective. Thus, even if one of ordinary skill in the art turned to Li and sought to add a surfactant to the composition of Xu *et al.*, the only reasonable decision would have been to add the more effective

type according to Li, an ionic surfactant. Once again, there would have been no reason for a skilled artisan to use a nonionic surfactant, not when Li teaches that an ionic surfactant is more effective. In any event, there is certainly no disclosure in Li of the nonionic surfactant of the present invention.

The Office Action cites Akahori *et al.* and asserts that the reference discloses the use of polyoxyethylenealkyl amine surfactants. The Action also states that the fact that Akahori *et al.* disclose a chemical-mechanical polishing abrasive with cerium oxide slurry particles is not relevant since the abrasive type does not matter. The applicants respectfully disagree. Starting with the silica particle slurry of Xu *et al.*, a skilled artisan would not have had a reason to seek out a reference that teaches a cerium oxide particle slurry. Thus, even assuming, for the sake of argument, that the surfactants of Akahori *et al.* could be used effectively with the slurry of Xu *et al.*, a skilled artisan would not have sought them out nor had a reasonable expectation of success in using them.

Furthermore, Akahori *et al.* do not disclose the nonionic surfactant of the present invention. The Office Action cites Maeno *et al.* and states that the surfactant of the present invention is well known. The Action also asserts that it is not relevant that Maeno *et al.* is non-analogous art because it is being used to show that the surfactant is known. The applicants respectfully disagree. The Examiner cites Maeno *et al.* for the proposition that the surfactant of the present invention is known to one of ordinary skill in the art of polishing compositions. Even assuming, for the sake of argument, that Maeno *et al.* disclose the claimed surfactant, it does not establish that a skilled artisan in the relevant field of polishing compositions would be aware of it. Additionally, there is certainly no reason why a skilled artisan would choose to include a surfactant of a detergent composition with the composition of Xu *et al.*

Moreover, new claim 7 has been added, which is directed to a composition including a surfactant that is not disclosed in any of the cited references. Thus, even assuming, for the sake of argument, that Xu *et al.*, Li, Akahori *et al.*, and Maeno *et al.* were combined, the applicants respectfully submit that a skilled artisan could not have arrived at the composition of claim 7.

As discussed above, a skilled artisan would not have had a reason to combine the cited references to arrive at the novel and advantageous composition of the present invention. Thus, the cited references cannot lead to the claimed invention without the use of hindsight reconstruction, which cannot support a §103 rejection, as was specifically recognized by the CCPA in *In re*

Sponnoble, 56CCPA 823, 160 USPQ 237, 243 (1969). Accordingly, reconsideration and withdrawal of the rejection under §103 is respectfully requested.

In view of the foregoing remarks and the amendments to the claims, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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